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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,984	02/14/2002	Kouichi Hirasawa	Q68472	6106

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SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, NW  
Washington, DC 20037-3213

EXAMINER

GHATT, DAVE A

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/073,984

Applicant(s)

HIRASAWA, KOUICHI *AW*

Examiner

Dave A Ghatt

Art Unit

2854 *AW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17, 19, 20, 21, 22, 23, 25, 27, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat (US 5,997,683) in view of Stewart (US 6,030,134). With respect to claims 17, 21, and 22 as outlined in the abstract, Popat teaches a method of printing an image on a printing paper using a laser printer. Popat teaches in column 5 lines 1-4, the step of accommodating a printing paper in an accommodating portion 58. Popat also teaches the step of conveying the printing paper from the accommodating portion to a recording device in column 5 lines 10-11. Figure 3 also illustrates the feeding with arrows 70. Column 5 lines 18-21 teach the step of printing an image on the printing paper by the recording device. With respect to the step of conveying the printing paper from the recording device to a discharging portion, Figure 2 shows a discharging portion on top of the printer, where the printing paper is discharged after printing. Although Popat does not specifically state that the conveying device nips margins of the printer, the applicant should note this is an inherent step in conventional printers as illustrated in Figure 2. In the feeding process, the printer of Popat must nip at least portions of 'margins' of the printer, to the extent that dimensions of margins are defined by the applicant. Popat also teaches the step of providing printing paper with printing portions and margins, illustrated in

Art Unit: 2854

Figures 5, 6, 7, and 9. As outlined in column 4 lines 21-26, detaching at least one printing portion from the printing paper after the printing paper with an image is discharged to the discharging portion forms the print. Popat teaches all the claimed requirements except for the step of nipping the printing paper at substantially spaced apart locations. Stewart teaches a printer similar to that of Popat. As illustrated in Figure 5, Stewart teaches the step of nipping printing paper 18 at substantially spaced apart locations. To one of ordinary skill in the art, it would have been obvious to use the feeding method of Stewart in the a method of Popat, in order to avoid adversely impinging on the printing portion, as taught in the Abstract of Stewart.

With respect to claim 19, as stated in the abstract, the recording device of the primary reference Popat, is set to print on at least one printing portion of the printing paper. With respect to the step of the margin allowing for errors generated when the recording device prints an image on the printing paper, the applicant should note that insofar as this step is defined, the margin of Popat also allows for errors.

With respect to claim 20, the primary reference Popat teaches in Figures 5 and 6, margins provided along a direction in which the conveying device conveys the printing paper.

With respect to claim 23, the primary reference Popat teaches in Figured 3 and 4, an intermittent line 208 orthogonal to the feeding direction and a continuous line 180 orthogonal to the one intermittent line 208, the lines 208 and 108 not cut through the base material. The p

With respect to claim 25, the primary reference Popat teaches the use of a plurality of the sheets illustrated in Figure 4. Each additional sheet meets the requirements of a second sheet as outlined.

With respect to claim 27, insofar as this step is broadly recited, the applicant should note that Figure 4 of the primary reference Popat teaches identical images that traverse several of the intermittent cut lines, which is enough to meet the requirements of this claim.

With respect to claim 28, in column 4 lines 20-21 of the primary reference, Popat teaches a printer that produces photographs.

With respect to claim 29, the primary reference Popat teaches paper stock which is inherently configured for use with a sublimation type heat transfer recording device .

3. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Popat (US 5,853,837) in view of Stewart (US 6,030,134) as applied to claims 17, 19, 20, 21, 22, 23, 25, 27, 28, and 29, above, and further in view of Shingu et al. (US 5,824,178). As outlined in the above rejections, Popat and Stewart teach all the claimed steps, including the step of providing a printing paper with a printing material, a base material, an adhesive layer, as illustrated in Figure 4. In fact, Popat and Stewart teach all the claimed steps except for setting a predetermined value for the sum of a thickness of printing paper, and the setting of a predetermined value for nipping pressure at which margins are nipped by the conveying device. Shingu et al. teaches a web-conveying device that conveys a web in a similar manner as taught by Popat. Shingu et al. teaches in column 12 lines 63-67, the setting of predetermined nipping pressure for a predetermined thickness of sheets. To one of ordinary skill in the art, it would have been obvious to use predetermined values as taught by Shingu et al., in the process of Popat in view of Stewart, in order to have different nip pressures based on different thickness, as taught by Shingu et al. in column 12 lines 63-65.

Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat (US 5,853,837) in view of Stewart (US 6,030,134) as applied to claims 17, 19, 20, 21, 22, 23, 25, 27, 28, and 29 above, and further in view of Bishop et al. (US 5,571,587). As outlined in the above rejections, Popat and Stewart teach all the claimed steps, except for a secondary printing material having a base material for supporting the printing material, and adhesive layer the removably adheres the printing material to the base material, and at least one intermittent cut line formed orthogonal to a conveying direction and a continuous cut line penetrating the printing material and extending in a longitudinal direction, wherein the continuous cut line and the at least one cut line do not cut through the base material. Bishop et al., as illustrated in Figures 1, 4, and 5, teach a printing material having a printing portion that comprises a base material 18 for supporting printing material 16, and an adhesive layer that removably adheres the printing material 16 to the base material 18, wherein the printing portion is detached from the printing material so as to form a finished print. Figure 2 of Bishop et al. also teaches at least one intermittent line 40 orthogonal to a conveying direction and a continuous cut line 34 orthogonal to the intermittent line, wherein the at least the one cut line 34 and the continuous line 40 do not cut through the base material. To one of ordinary skill in the art, it would have been obvious to use the sheet material of Bishop et al., as a receiver in the method of Popat in view of Stewart, in order to provide sheet stock which may easily be used to produce business cards, party invitations, and file cards.

With respect to claim 26, Popat in view of Stewart teaches all the claimed steps except for a second printing paper comprising a base material and an adhesive as outlined. Bishop et al. teaches the use of a plurality of the sheets illustrated in Figure 2. Each additional sheet meets the

Art Unit: 2854

requirements of a second sheet as outlined. As stated above, To one of ordinary skill in the art, it would have been obvious to use the sheet material of Bishop et al., as a receiver in the method of Popat in view of Stewart, in order to provide sheet stock which may easily be used to produce business cards, party invitations, and file cards.

### ***Response to Arguments***

4. The examiner has considered the applicant's amendment filed September, 29, 2003. Applicant's arguments with respect to claim 17-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2854

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave A Ghatt whose telephone number is (703) 308-2417. The examiner can normally be reached on Mondays through Friday 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H Hirshfeld can be reached on (703) 305-6619. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3431.

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